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EXAMINER
SMITH, BENJAMIN J

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/581,153	BJORK, MAGNUS
Office Action Summary	Examiner	Art Unit	
	Benjamin J. Smith	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>13 February 2007</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-14</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-14</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>13 February 2007</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/13/2007</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This non-final office action is in response to the Application filed on 2/13/2007,

with a priority date of 11/30/2004 and 12/02/2003.

Claims 1-14 are presented for examination. Claims 1 and 8 are independent

claims.

Specification

The specification is objected to as failing to provide proper antecedent basis for

the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: the recited "computer readable media" of Claim 13.

The Specification does not mention the recited "computer readable media."

Thus, there is no support or antecedent basis for the recited elements that allows the

meaning of the term to be ascertained, as required in 37 CFR 1.75(d)(1).

Claim Objections

Claims 4-7 and 11-14 are objected to under 37 CFR 1.75(c) as being in improper

form because a multiple dependent claim should refer to other claims in the

alternative only. See MPEP § 608.01(n).

Claims 12-14 are objected to because of the following informalities:

- the claims recite the term "programme", there appears to be a spelling translation

  error and the claims should be corrected. The term "programme" is also not

  mentioned in the applicant's specification

Claim 1 is objected to because of the following informalities:

- the claim recites the limitation "the unique third entity" in line 20. There is

  insufficient antecedent basis for this limitation in the claim.

- the claim recites the limitation "information entity in dependence or each other" in

  lines 12-13. This wording is unclear.

- the claim recites the limitation "terminal further is arranged" in line 15. This

  wording is unclear.

Claim 8 is objected to because of the following informalities:

- the claim recites the limitation "said unique third entity" in line 21. There is

  insufficient antecedent basis for this limitation in the claim.

- the claim recites the limitation "information entity in dependence or each other"

  in line 16. This wording is unclear

. Claim 13 is objected to because of the following informalities:

- the claim recites the limitation "program code stored on a, by a computer

  readable, media" in lines 1-2. This wording is unclear.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12-14:

Claims 12-14 are rejected because the claims recite software not clearly stored on a statutory computer-readable medium.

Examiners Interpretation of Claim 1:

For purposes of USC 101, the examiner has regarded the "communication terminal" as necessarily including hardware (see paragraph 0024 of the published specification). That is to say the "communication terminal" is interpreted as being hardware only or having hardware parts and not merely being software only.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-14 rejected under 35 U.S.C. 103(a) as being unpatentable over

Chalecki et. al. US Patent No. 7,451,392 (hereinafter, "Chalecki") and further in view of

Daconta et. al. US Patent No. 7,299,408, (hereinafter "Daconta").

Claim 1:

Chalecki teaches:

System for administrating at least one electronic document, the system

comprising [abstract]*:*

a communication terminal (105) adapted for communication with a server (115)

via a network (110), said server being adapted for communication with a database (120)

[col. 5, lines 13-22 and col. 3, lines 49-57]*, characterized in that,*

the electronic document comprises a first information entity and a second

information entity [col. 7, lines 14-32] [one file contains many files, including XML and

HTML]*, wherein*

the communication terminal (105) is arranged to display the first and the second

information entity in dependence of each other and for providing information to the

second information entity [col. 7, lines 34-59] [data files packaged together "in

dependence" of each other]*, wherein*

Chalecki fails to teach:

said communication terminal further is arranged to generate a third information

entity comprising at least part of the first and second information entity and the provided

information by converting means, wherein

said communication terminal further is arranged to make the third information

entity unique, and wherein

said server is adapted to transmit at least a part of the unique third entity to a receiving

unit (120; 130).

Daconta teaches:

said communication terminal further is arranged to generate a third information

entity comprising at least part of the first and second information entity and the provided

information by converting means [col. 4, lines 14-45] [first, second and third parts are

described as shown in the figure, the multiple parts to the document described could be

the parts described in Chalecki as well, only with the addition of a signature portion],

wherein

said communication terminal further is arranged to make the third information

entity unique [col. 10, line 43 – col. 11, line 36] [add signature to document, where the

signature is unique to the document], and wherein

said server is adapted to transmit at least a part of the unique third entity to a receiving

unit (120; 130) [col. 4, lines 46-59] [document can be separated or stripped and

transmitted].

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of document display and form creation in Chalecki with the method of form validation and digital signatures in Daconta.

This combination would have been useful to allow the user the ability to sign documents electronically.

Claim 2:

Chalecki teaches: *System according to claim 1, characterized in that said second information entity is created in dependence of said first information entity* [col. 7, lines 34-59] [data files packaged together "in dependence" of each other].

Claim 3:

Chalecki teaches: *System according to claim 1 or 2, characterized in that the first information entity and the second information entity are mutually different* [col. 7, lines 34-59] [data files can be separate].

Claim 4:

Chalecki teaches: *System according to claim 1-3, characterized in that the first information entity is an HTML-file* [col. 8, lines 17-57] [contains an HTML file].

Claim 5:

Chalecki teaches: *System according to claim 1-4, characterized in that the second information entity is an XML-file* [col. 8, lines 17-57] [contains an XML file].

Claim 6:

Daconta teaches: *System according to claim 1-5, characterized in that the third information entity is an XML-file* [col. 5, lines 4063] [signature is in an XML file].

Claim 7:

Chalecki teaches: *System according to claim 1-6, characterized in that the communication terminal is adapted to display the first and the second information entity by means of a web-browser* [col. 1, lines 40-59] [HTML, XML and XSLT used because they cad be displayed on a web browser].

Claim 8:

Chalecki teaches:

Method for administrating at least one electronic document, characterized by the steps of [abstract]:

requesting the electronic document, which document comprises a first and a second information entity [col. 7, lines 14-32] [one file contains many files, including XML and HTML],

displaying said first and a second information entity in dependence of each other
[col. 7, lines 34-59] [data files packaged together "in dependence" of each other],

providing information to said second information entity [col. 6, lines 33-45]
[provide information about data or forms],

Chalecki fails to teach:

generating a third information entity, which entity comprises information related to
said first and second information entities and the provided information,

making the third information entity unique, and

transmitting said unique third entity.

Daconta teaches:

generating a third information entity, which entity comprises information related to
said first and second information entities and the provided information [col. 4, lines 14-
45] [first, second and third parts are described as shown in the figure, the multiple parts
to the document described could be the parts described in Chalecki as well, only with
the addition of a signature portion],

making the third information entity unique [col. 10, line 43 – col. 11, line 36] [add
signature to document, where the signature is unique to the document], *and*

transmitting said unique third entity [col. 4, lines 46-59] [document can be
separated or stripped and transmitted].

It would have been obvious to one having ordinary skill in the art at the time of the invention to combine the method of document display and form creation in Chalecki with the method of form validation and digital signatures in Daconta.

This combination would have been useful to allow the user the ability to sign documents electronically.

Claim 9:

Daconta teaches: *Method according to claim 8, characterized by making said third information entity unique by applying a digital signature* [col. 10, line 43 – col. 11, line 36] [add signature to document, where the signature is unique to the document].

Claim 10:

Chalecki teaches: *Method according to claim 8 or 9, characterized by displaying said first and a second information entity such that they are aligned in a predetermined way* [col. 11, lines 14-29] [forms are "aligned" in that the schema's don't interfere].

Claim 11:

Chalecki teaches: *Method according to claim 8-10, characterized by displaying said first and second information entity by means of a web-browser* [col. 1, lines 40-59] [HTML, XML and XSLT used because they cad be displayed on a web browser].

Claim 12:

Chalecki teaches: *Computer programme comprising a programme code for performing the method steps of claim 8-11 when said computer programme is run on a computer* [col. 26, lines 18-68] [computer with program on it].

Claim 13:

Chalecki teaches: *Computer programme product comprising a program code stored on a, by a computer readable, media for performing the method steps of claim 8-11, when said computer programme is run on the computer* [col. 26, lines 18-68] [computer with program and code stored on it].

Claim 14:

Chalecki teaches: *Computer programme product directly storable in an internal memory into a computer, comprising a computer programme for performing the method steps according to claim 8-11, when said computer programme is run on the computer* [col. 26, lines 18-68] [computer with program and with storage media].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin J. Smith whose telephone number is (571) 270-3825. The examiner can normally be reached on Monday through Friday 8:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin J. Smith/
Examiner, Art Unit 2176

/DOUG HUTTON/
Supervisory Patent Examiner, Art Unit 2176